APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,112	12/30/1999	JON N. LEONARD	BEU/LEONARD2	5971

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EXAMINER
MUHEBBULLAH, SAJEDA

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

		Application No.	Applicant(s)
Office Action Summary		09/475,112	LEONARD ET AL.
		Examiner	**Art Unit**
		Sajeda Muhebbullah	2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20, 22-23 and 25-30* is/are rejected.

7)☒ Claim(s) *21 and 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   This communication is responsive to Amendment A, filed 9/19/2002.

2.   Claims 1-30 are pending in this application. Claims 1, 6, 11, 14-15, 19, 22, and 25 are

independent claims. In the Amendment A, claims 1, 6, 11, 14, 18, 23-30 were amended. This

action is made Final.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Henderson et

al. ("Henderson", US 6,185,603).

As per independent claim 11, Henderson teaches an electronic mail system, comprising:

a first computer on which is installed message origination software and which is

connected to a network capable of carrying an electronic mail message and at least one

recipient computer also connected to said network (col.2, lines 56-66; col.3, line 1); and

a viewer applet installed on said recipient computer (col.4, lines 53-55; col. 5, line 1),

said viewer applet being arranged to decode control information appended to the

electronic mail wrapper, search for sender-identity and message-origination fields in said

wrapper (col.5, lines 41-44, lines 52-55) and control, based on input to said message

origination software, a manner in which information items in said selected fields in said

wrapper are presented to a recipient of the message (col.4, lines 53-56), said control

including selection of which of said information items are to be presented, and control of

coupling of the information and the message (col.3, lines 61-64; col.4, lines 63-66).

As per claim 12, Henderson teaches the electronic mail system of claim 11, further

comprising a central electronic mail server connected to said network, said electronic mail server

being arranged to cooperate with said viewer applet to achieve said control of the manner in

which the electronic mail wrapper is presented to the recipient (col.4, lines 58-65).

5.   Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al.

("Ogilvie", US 6,324,569).

As per claim 14, Ogilvie teaches a method of controlling an electronic mail message

transmitted over a network, comprising the steps of:

after transmission of the electronic mail message over the network, identifying and

selecting information in a message wrapper associated with the electronic mail message

(col.5, lines 28-32); and

encrypting said electronic mail message so that only said selected information in said

associated message wrapper can be viewed with the message when the electronic mail

message is decrypted using a viewer applet installed on a recipient computer (col.5, lines

52-54; col.16, lines 8-13).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne et al. ("Thorne", US 5,958,005) in view of Netscape 2 Simplified ("Netscape").

As per independent claim 1, Thorne teaches an electronic mail control software comprising:

means for opening a window arranged to enable a user of the electronic mail applications program to select an original destination address to which an electronic mail message created using the electronic mail applications program is to be sent (claim 1, lines 5-6), and control options to be applied to an electronic mail message (col.6, lines 45-48). Although it is inherent that a recipient's address must be entered to direct the email to its destination and Thorne teaches the delivery of the message via a server, Thorne does not disclose a means for causing the electronic mail control software to substitute an address of a central mail server for the original destination server address in order to divert said electronic mail message to a central mail server arranged to forward said electronic mail message to said original destination address. Netscape teaches an email system that includes a means for modifying an address of the mail server to which the messages are to be sent (pg.112, step 9; *Outgoing Mail Server*). It would have been obvious to an artisan at the time of the invention to include Netscape's method with Thorne's email system in order to direct the message to a central mail server arranged to implement the control options.

As per claim 2, Thorne teaches the electronic mail control software of claim 1, wherein said control options include an expiration setting by which the user may select a date, time, or event, the occurrence of which will cause said message to expire (col.6, line 61).

As per claim 3, Thorne teaches the electronic mail control software of claim 1, wherein said control options include limitations on forwarding by a recipient of said message (col. 6, line 54).

As per claim 4, Thorne teaches a means for opening a window in response to interception of a command (col.7, lines 9-11). However, Thorne's command is a compose command rather than a send command. Although Thorne intercepts a command other than the send command, in effect both achieve the same results of opening a window prior to transmission of the message. It would have been obvious to an artisan at the time of the invention to modify Thorne's teaching to open a window in response to interception of any command, in this case it could be the send command, as long as it is prior to transmission of the message.

As per claim 5, Thorne teaches the delivery of messages via a server. However, Thorne fails to teach a means for modifying at least one entry in an address book. Netscape teaches a means for modifying an entry in an address book (pg. 122-123, step 4-5). It would have been obvious to an artisan at the time of the invention to include Netscape's method with Thorne's email system in order to store the email addresses used frequently and saving time from having to type the address over.

Claims 6-10 are similar in scope to claims 1-5 respectively, and are therefore rejected under similar rationale.

8.   Claims 13, 15, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. ("Henderson", US 6,185,603) in view of Ogilvie et al. ("Ogilvie", US 6,324,569).

As per claim 13, although Henderson teaches a central mail server cooperating with a viewer applet arranged to display the email message with information deleted from the wrapper, Henderson fails to teach the mail server to encrypt the message and sending it to the viewer applet to decrypt the message for viewing. Ogilvie teaches an email system providing the originator control over the message where the message is encrypted and requires a key from the recipient to decrypt the message for viewing through the viewer applet (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to an artisan at the time of the invention to combine Ogilvie's teaching with Henderson's email system in order to provide security to messages sent over a network where only the intended recipient can view the message.

As per claim 15, Henderson teaches a method of controlling an electronic mail message transmitted over a network, comprising the steps of:

before transmission of the electronic mail message over the network, attaching limitations on processing and handling of the electronic mail message by a recipient (col.3, lines 61-63);

initially transmitting said electronic mail message over said network to a central electronic mail server (col.4, lines 44-45);

storing said electronic mail message at said electronic mail server (col.2, lines 57-58); Henderson teaches a central mail server cooperating with a viewer applet on the recipient computer arranged to display the email message with information deleted from the wrapper. However, Henderson fails to teach the mail server to encrypt the message, store the message on the recipient computer, sending it to the viewer applet to decrypt the message using a session key, and causing the server and applet to implement the processing and handling limitations. Ogilvie teaches an email system providing the originator control over the message where the

message is encrypted and requires a key from the recipient to decrypt the message for viewing

through the viewer applet (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to

an artisan at the time of the invention to combine Ogilvie's teaching with Henderson's email

system in order to provide security to messages sent over a network where only the intended

recipient can view the message.

Claim 19 is similar in scope to the combination of claims 13 and 15, and is therefore

rejected under similar rationale.

Claim 22 is similar in scope to claim 15, and is therefore rejected under similar rationale.

9.   Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson

et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US 6,324,569) as applied to

claim 15 above, and further in view of Whitehouse (US 6,005,945).

As per claim 16, the method of Henderson and Ogilvie teaches the use of a key to decrypt

the message for displaying. However, Henderson and Ogilvie fail to teach the session key to be

supplied by the server each time the message is to be viewed. Whitehouse teaches a method of

encrypting data messages whereby a session key is provided by a central server each viewing

transaction (col.9, lines 16-21, lines 64-66). It would have been obvious to an artisan at the time

of the invention to include Whitehouse's teaching with the method of Henderson and Ogilvie in

order to prevent the risk of tampering of the session key and provide security to messages sent

over a network where only the intended recipient can view the message.

As per claim 17, the method of Henderson and Ogilvie teaches the use of a key to decrypt

the message for displaying. However, Henderson and Ogilvie fail to teach the session key to be

renewed periodically in order to view the message. Whitehouse teaches a method of encrypting

data messages whereby a session key is periodically renewed by a central server (col.9, lines 40-42; col.12, lines 53-56). It would have been obvious to an artisan at the time of the invention to include Whitehouse's teaching with the method of Henderson and Ogilvie in order to prevent the risk of tampering of the session key and provide security to messages sent over a network where only the intended recipient can view the message.

Claim 18 is similar in scope to claim 17, and is therefore rejected under similar rationale.

10.   Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US 6,324,569) as applied to claim 19 above, and further in view of Smith et al. ("Smith", US 6,061,448).

As per claim 20, the method of Henderson and Ogilvie teaches the use of a key to decrypt the message for displaying. However, Henderson and Ogilvie fail to teach the message to be encrypted by the server using a public key generated by the viewer applet and decrypting the message using an associated private key. Smith teaches a method for secure document delivery whereby a server encrypts a message using a public key generated by an applet and the corresponding private key generated by the applet is used by the recipient to decrypt the message (col.5, lines 11-13, lines 61-66; col.6, lines 1-4). It would have been obvious to an artisan at the time of the invention to include Smith's teaching with the method of Henderson and Ogilvie in order to provide security to messages sent over a network where only the intended recipient can view the message.

Claim 23 is similar in scope to claim 20, and is therefore rejected under similar rationale.

11.   Claims 25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nielsen (US 5,864,684) in view of Anderson (US 6,442,600), Sidhu et al. ("Sidhu", US

5,734,901) and Druckenmiller et al. ("Druckenmiller", US 6,167,435).

As per claim 25, Nielsen teaches a mailing list comprising the step of sending an

electronic mail message to an initial list of recipients (col.1, lines 54-55) and requiring that

forwarded versions of said electronic mail message be routed through at least one central mail

server (col.2, lines 1-15). Nielsen fails to teach requiring that versions of the message forwarded

to additional recipients be routed through the central mail server, tracking all transactions

involving said electronic mail message and using a record of at least a portion of said

transactions to expand said electronic mailing lists. Anderson teaches a method of distributing

email using a central server whereby a message forwarded to additional recipients is routed

through the central mail server (col.2, lines 2-19; col.4, lines 39-43). It would have been obvious

to an artisan at the time of the invention to combine Anderson's teaching with Nielsen's mailing

list server in order to manage the distribution of the message more efficiently. Although the

method of Nielsen and Anderson teach the routing of versions of the message through a central

server, the method fails to teach tracking all transactions involving said electronic mail message

and using a record of at least a portion of said transactions to expand said electronic mailing lists.

Sidhu teaches a method of e-mail whereby previous transactions are tracked within the email

application (col.9, lines 34-60). It would have been obvious to an artisan at the time of the

invention to include Sidhu's teaching with Nielsen's mailing list in order to view the history of

the message to gather possible recipients interested in similar messages. Although the method of

Nielsen, Anderson and Sidhu teaches the routing and tracking of email transactions, the method

of Nielsen, Anderson and Sidhu fails to teach the step of using a record of at least a portion of

said transactions to expand said electronic mailing list. Druckenmiller teaches a method of

generating electronic mailing lists whereby a record of possible recipients to add to the list is

used to expand the mailing list (col.3, lines 23-26, lines 64-66). It would have been obvious to

an artisan at the time of the invention to include Druckenmiller's teaching with the method of

Nielsen, Anderson and Sidhu in order to further expand the mailing list to interested individuals.

As per claim 28, Sidhu teaches a record of all address to which the message has been

forwarded (col.9, lines 55-57).

Claim 29 is similar in scope to claim 28, and is therefore rejected under similar rationale.

As per claim 30, in addition to all claim limitations as applied to claim 25,

Druckenmiller further teaches selling of a mailing list (col.1, lines 14-15).

12.   Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen

(US 5,864,684), Anderson (US 6,442,600), Sidhu et al. ("Sidhu", US 5,734,901) and

Druckenmiller et al. ("Druckenmiller", US 6,167,435) as applied to claim 25 above, and further

in view of Henderson et al. ("Henderson", US 6,185,603) and Ogilvie et al. ("Ogilvie", US

6,324,569).

As per claim 26-27, although the method of Nielsen, Anderson, Sidhu, and

Druckenmiller teaches the transmission of an electronic message, the method of Nielsen,

Anderson, Sidhu, and Druckenmiller fails to teach the attachment of handling limitations that

will cause the message to expire and encryption of the message to be viewed by a viewer applet

before the set expiration date. Henderson teaches the step of before transmission of the message,

attaching handling limitations such as when the message will expire (col.7, lines 26-29). It

would have been obvious to an artisan at the time of the invention to combine Henderson's

teaching with the method of Nielsen, Anderson, Sidhu, and Druckenmiller in order to provide

convenience to the user from having to delete previous emails. Although the method of Nielsen,

Anderson, Sidhu, Druckenmiller, and Henderson teaches the viewing of an email prior to

expiring, the method of Nielsen, Anderson, Sidhu, Druckenmiller, and Henderson fails to teach

the encryption of the message to be viewed by a viewer applet before the set expiration date.

Ogilvie teaches encrypting the message to be viewed by a viewer applet supplied by the central

server (col. 9, lines 33-43; col. 16, lines 8-13). It would have been obvious to an artisan at the

time of the invention to combine Ogilvie's teaching with the method of Nielsen, Anderson,

Sidhu, Druckenmiller, and Henderson in order to provide security to messages sent over a

network where only the intended recipient can view the message.

Allowable Subject Matter

13.   Claims 21 and 24 are objected to as being dependent upon a rejected base claim, but

would be allowable if rewritten in independent form including all of the limitations of the base

claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

The prior art made of record fails to anticipate or make obvious the claimed invention.

Although the method of Henderson and Ogilvie teaches the viewer applet to be arranged

to permit a user to request forwarding of said electronic mail message to a recipient computer,

said central mail server being arranged to strip and store information concerning said message, a

copy of the viewer applet installed on said recipient computer being arranged to store said

stripped message, the method of Henderson and Ogilvie fails to teach the method wherein the

viewer applet is arranged to perform various steps in conjunction with a second recipient computer as recited in claims 21 and 24.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

14.   Applicant's arguments with respect to claims 25 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments in the Amendment A have been fully considered but they are not persuasive.

Applicants argued the following:

(a) Per claim 11, Henderson fails to disclose the information to be controlled by a viewer applet on the recipient's computer.

(b) Per claim 1, Netscape discloses entering in the address of the recipient and does not disclose the substitution of the server address for the destination address.

(c) Per claims 13-15, 19 and 22, Ogilvie fails to disclose encryption of a message.

(d) Per claim 16, Whitehouse fails to disclose the control of a message wrapper by encryption, whether or not a session key is used.

(e) Per claim 18, Whitehouse does not disclose clock checking.

(f) Per claim 20 and 23, Smith fails to disclose generation of a public-private key pair by a viewer applet.

The Examiner disagrees for the following reasons:

Per (a), as noted in the rejection above, Henderson does teach the information to be controlled by the viewer applet on the recipient's computer (col.4, lines 63-66; col.5, lines 1-2).

Per (b), Netscape does disclose the substitution of the server address for the destination address in which the server receives the messages and forwards them to their destination (page 112, step 9; *Outgoing Mail Server*). As cited in the rejection above, Netscape teaches typing the address of the computer (page 112, step 9; *server*) not the recipient.

Per (c), Examiner wishes to bring to the Applicant's attention to look more carefully at the cited passages (col.16, lines 8-13). It appears from Applicant's argument that Applicant has misread the cited passages from the Office Action. The cited passages clearly disclose the encryption of the message.

Per (d), as noted in argument (b), encryption is taught by the method of Henderson and Ogilvie. In addition, Whitehouse is cited solely for the teaching of the supply of a session key each time a message is to be viewed which is clearly taught as noted in the rejection above (col.9, lines 16-21, lines 64-66).

Per (e), since Whitehouse teaches the periodic replacement of the session key by the central computer, it is inherent that the clock would be functioning properly if there is communication with the server periodically since the clock is used to measure the periodic time interval.

Per (f), as noted in the rejection above, Smith clearly discloses the generation of a

public-private key pair by an applet (col.5, lines 11-13).

Conclusion

15.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Inquiries

16.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Sajeda Muhebbullah whose telephone number is **(703) 305-3989**.
The examiner can normally be reached on Monday - Thursday from 7:00 am to 4:30 pm (EST).
The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax number for the organization where this application or proceeding is assigned are
as follows:

(703) 746-7238 [After Final Communication]

(703) 746-7239 [Official Communication]

(703) 746-7240 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajeda Muhebbullah
Patent Examiner
December 11, 2002

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
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